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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,135

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Juro Ozeki

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22852

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12/10/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER

LLP

901 NEW YORK AVENUE, NW

WASHINGTON, DC 20001-4413

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

12/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,135

Applicant(s)

OZEKI ET AL.

Examiner

Patrick D. Niland

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1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5 and 6 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 3, and 5-6 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 10/9/08
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

1. The amendment of 4/19/07 has been entered. Claims 1, 3, and 5-6 are pending.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5332784 Shiraki et al. in view of US Pat. No. 4433114 Coran et al..

Shiraki et al. discloses mixtures of polyphenylene ethers, polymers including styrene based thermoplastic elastomers modified with imidazolidinone compound in the instantly claimed amounts at the abstract; column 4, lines 45-53; column 6, line 33 to column 8, line 40; column 9, lines 22-62, particularly 53-60; column 12, lines 16-24; column 16, lines 19-68; column 17, lines 11-12; column 20, lines 53-68, which encompasses the instantly claimed polyphenylene ether based resin; column 21, lines 1-14 and 45-68; column 22, lines 1-38, particularly 20-38, which encompasses the instantly claimed amounts of components (a) and (b); column 25, lines 51-54, which encompasses the instantly claimed clay fillers, and lines 57 of which "other additives" encompasses the well known flame retarder additives; and the remainder of the document.

It would have been at least obvious to one of ordinary skill in the art at the time of the instant invention to use the above discussed combinations of ingredients and amounts thereof because they are encompassed by Shiraki et al., exemplified and would have been expected to give the properties disclosed by Shiraki et al..

Shiraki et al. does not disclose the instantly claimed surface treatment nor the flame retardant of claim 5.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the clay filler of Shiraki et al. treated with the compounds of the instant claims 1 and 3 because they are broadly encompassed by Shiraki et al. by the broad recitation of “filler” and the general recitation of “clay” and such fillers are shown by Coran to be known for improved reinforcing properties to rubber compositions (Coran, column 17, lines 50-58), and this improved reinforcement would have been expected in the composition of Shiraki et al. and the clays exemplified by Coran have the instantly claimed particle size of claim 6 (column 17, lines 55-62 of Coran).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the compound of the instant claim 5 in the broad amount range claimed because the general class of compounds are disclosed at column 25, line 57 and column 29, lines 20-23 of Shiraki et al. and using larger amounts, which are encompassed by the lack of limits on the amounts of such additives by Shiraki et al., would have been expected to give greater stabilization.

Arguments related to only the examples of Shiraki are not commensurate in scope with the full teachings of Shiraki and the above rejection. These arguments are therefore not persuasive. Arguments relating to Coran alone are not commensurate in scope with its use in the above rejection and are therefore not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). These arguments do not address the purpose for which Coran was cited.

Arguments relating to adding clay to polyphenylene ether alone is not commensurate in scope with the above rejection. Shiraki adds the clay to polyphenylene ether and the instantly claimed imidazolidinone modified styrene thermoplastic elastomer, which elastomer will improve impact properties due to the nature of elastomers seen when they are struct with an impact blow, e.g. they bounce back. These arguments do not address the cited prior art.

Arguments to the various argued examples do not address the above rejection, which is not limited to these examples. These examples are also not commensurate in scope with the instant claims and the cited prior art.

Arguments relating to Shiraki and Coran being distinct from each other do not rebut the above obviousness rationale. If they were not distinct they would be equivalent to each other. Then we would not have 35 USC 103, if references were required to be equivalents. The above rationale for combining the references is proper under *Graham v. Deere* and *KSR*. See MPEP 2141. The reinforcing properties obtained from treating clays, as taught by Coran, is equally expected in Shiraki's compositions by the ordinary skilled artisan. No reason is seen why this would not be. Coran is not cited for the combination of the instantly claimed A and B. Shiraki is. Shiraki also teaches the clay fillers and the typical treatments of fillers, including the treatment taught by Coran, are expected to give their typical results to the fillers of Shiraki also. This does not use impermissible hindsight. Again, see MPEP 2141, particularly the *KSR* decision cited therein. The above cited motivation to combine Shiraki and Coran is a clearly articulated reasons why the claimed invention would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention.

There is no showing of unexpected results commensurate in scope with the instant claims and the cited prior art. The applicant's arguments have been fully considered but are not persuasive for the above reasons. This rejection is therefore maintained for the above reasons.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796